

REMARKS

Reconsideration of this application is requested.

Claims 1-13, 18, 22-24 and 26-28 are currently pending in this application for the Examiner's review and consideration. Claims 1, 3-4 and 6-10 have been amended in accordance with the Examiner's suggestions on pages 2 and 3 of the Office Action. Claim 18 has been amended to address the double patenting rejection on page 4 of the Office Action. In accordance with the Examiner's suggestion, new claims 27 and 28 have been added to include features deleted from claims 3 and 4. No new matter has been added.

The Examiner is requested to reconsider and withdraw the objections to claims 1, 3, 4, 6 and 7 in view of the foregoing amendments which are thought to be in accordance with the Examiner's suggestions.

The Examiner is also requested to reconsider and withdraw the Section 112, second paragraph, rejection of claims 1, 6 and 8-10 in view of the foregoing amendments to the claims so as to include the standard Markush language, "selected from the group consisting of," as suggested by the Examiner.

The Examiner is also requested to reconsider the proposed double patenting objection to claim 26 as a duplicate of claim 18. The applicants have amended claim 18 such that claims 18 and 26 are not duplicative of each other or even close in content. Accordingly, the applicants respectfully request reconsideration of the objection

The Examiner is requested to reconsider the Section 102(b) rejection of claims 1-13, 18, 22 and 26 as anticipated by EP 155780 for the reasons that follow.

EP0155780 teaches a very broad class of infra-red absorbing phthalocyanine compounds of general formula I.

It is worth noting that EP155780 is acknowledged in the present application on page 1 and was cited in the Information Disclosure Statement and International Search Report. The claims of the present invention were acknowledged in the International Search Report to be both novel and inventive (nonobvious) over this reference.

Furthermore, the applicants submit that, while EP155780 discloses a very large class (or genus) of compounds, the claims of the present invention are limited to a specific sub-class (or sub-genus) of compounds which are not identified as such in EP155780.

More specifically, the sub-class of compounds in the claimed invention is defined as having the following features in combination:

- at least the 8 groups represented by R^1 , R^4 , R^5 , R^8 , R^9 , R^{12} , R^{13} and R^{16} are substituted (EP155780 requires only at least 5 of these groups to be substituted);
- these at least 8 groups are identical and are $-X-J$ wherein X and J are as defined in claim 1;
- M is an oxymetal selected from VO, TiO and MoO (the embodiments taught in EP155780 overwhelmingly contain metals, not oxymetals).

Moreover, not one of the exemplified compounds in EP155780 falls within the present claims, since not one of the reference compounds has the claimed combination of features outlined above.

It is also worth noting that the applicants' compounds show a high λ_{max} value. Furthermore, the applicants' compounds also possess a high value of extinction coefficient (E_{max}) and a narrow band width at half peak height. These properties are evident from the table on page 33 of the present application. For example, the presently claimed compounds shown on page 33 have λ_{max} values ranging from 829-850 nm, whereas most of the prior art compounds have λ_{max} values around 800 nm or less. Simultaneously, the claimed compounds exhibit large E_{max} values, e.g., greater than 167,000 as shown on page 33, whereas the prior art compounds, on average, have much lower E_{max} values. All of these properties are important for infrared absorbing dyes and links, and the presently claimed class provides a unique combination of high λ_{max} value, high extinction coefficient value and narrow band width which is not achieved by the compounds disclosed in EP155780.

In view of the above, it is clear that EP155780 does not disclose any compound which falls within claim 1 of the present invention. Nor does EP155780 disclose a genus which even overlaps with the sub-genus recited in claim 1. Moreover, the improved properties of the claimed compounds are not disclosed in or predictable from the prior art. Accordingly, claim 1 is not anticipated by EP155780 and cannot be regarded as obvious therefrom. Since claims 2-13, 18, 22 and 26 depend, directly or indirectly, from claim 1, these claims cannot be anticipated by or obvious from EP155780. Withdrawal of the Section 102(b) rejection of claims 1-13, 18, 22 and 26 is, therefore, requested.

The Examiner is also requested to reconsider the Section 103(a) rejection of claims 23 and 24 as unpatentable over EP 155780 in view of U.S. Patent No. 5,282,894 to Albert *et al.* ("Albert") for the reasons that follow.

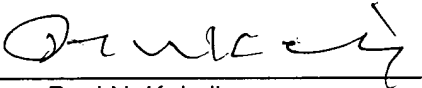
Albert teaches a liquid printing ink for security printing comprising a phthalocyanine dye, a solvent, a binder such as polyacrylate or polymethacrylate and, optionally, a colorant.

The Examiner acknowledges that EP0155780 fails to teach the addition of a colorant or an acrylate monomer to the infra-red ink composition as recited by the applicants in claims 23 and 24. Albert is thus cited for its alleged disclosure of these additional limitations. However, claims 23 and 24 depend from claim 1, which as discussed above, is novel and nonobvious over EP0155780. Albert does nothing to fill in the aforementioned deficiencies of EP0155780 with respect to claim 1. Accordingly, the combination of EP0155780 and Albert does not render obvious claims 23 and 24 of the present invention.

Favorable reconsideration with allowance of the application is requested.

Respectfully submitted,

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